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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/714,189 11/17/00 ITO

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022850 MMC2/0906
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EXAMINER

CRUZ, M

ART UNIT

PAPER NUMBER

2851

DATE MAILED: 09/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/714,189

Applicant(s)

ITO ET AL.

Examiner

Magda Cruz

Art Unit

2851

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: ____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

- (a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.
- (b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.
- (c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because it fails to adequately define what the applicant means with "embellishment image memory".

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 11-15 and 21 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure, which is not enabling. The definition of "embellishment image memory" is critical or essential to the practice of the invention. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Even in the specification, there is no detailed explanation of what the applicant means with "embellishment image memory".
5. Claim 21 falls with parent claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claim Rejections - 35 USC § 103

7. Claims 1-23 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Van Hook, et al.

Van Hook, et al. (US Patent Number 6,239,810 B1) shows the features of the applicant's invention.

Van Hook, et al. discloses a display apparatus that carries out processing with information stored in a portable memory (Figure 5), comprising: a memory controller configured to read out the information stored in the portable memory (54, 206); an image processing section configured to prepare display image data representing an image to be displayed from said image data stored in the portable memory according to an instruction of a processing program which is read from the portable memory and which represents a series of processing steps to be executed by the projection display apparatus (100, 200); and an optical system configured to project the image light to display the image (60); wherein the control of the projection display apparatus includes control of an electric power supply circuit (50, 400); wherein the apparatus is configured to reproduce sound based on the information stored in the portable memory (112a, 208); wherein the image processing section is configured to select at least one of image data supplied externally and image data read from the portable memory according to an instruction of selection included in the processing program, and to prepare the display image data using the selected image data (200, 300); wherein the image processing section comprises a processing program editor configured to edit the processing program, and the memory controller is configured to write the processing program edited by the processing program editor into the portable memory (138, 154, 152); an electro-optical device (58) configured to form an image light in response to the display image data, and wherein the image processing section is configured to control the

projection display apparatus according to an instruction of the processing program (140, 144).

Alternately, Van Hook, et al. does not explicitly present a projection system as the one disclosed (for example) by the applicant in Figure 1, however it would have been obvious to one of ordinary skill in the art at the time of the invention to replace element 58 of Van Hook's invention with a large screen projection television, for the purpose of having a large screen display. Furthermore, the applicant should note that replacing one type of video display for another is well known in the art.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy, et al in view of Akiko, et al.

Kennedy, et al. (US Patent Number 5,231,434) teaches the salient features of the applicant's invention. Applicant is referred to review column 4, line 24 to column 5, line 19, wherein it is shown that Kennedy's invention can run programs although is not explicitly explained (for example, Power Point).

Akiko, et al. (JP 10134030 A) discloses an automatic multimedia program for data presentation.

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize Akiko's features in Kennedy's invention for the purpose of efficiently and automatically executing the complicated presentations of multimedia data.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cooper, et al. (US Patent Number 5,737,416) teaches a method and apparatus provided in a data processing system for sending access to particular files, which are stored in a computer-accessible memory media.

Baldwin (US Patent Number 4,994,987) teaches an electro-optical device configured to form an image light in response to the display image data (column 4, lines 17-26), and wherein the image processing section is configured to control the projection display apparatus according to an instruction of the processing program (Figure 3).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Magda Cruz whose telephone number is (703)308-6367. The examiner can normally be reached on Monday through Thursday 8:00-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russ Adams can be reached on (703)308-2847. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703)746-4355 for regular communications and (703)308-5841 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1782.

A handwritten signature in black ink, appearing to read 'C. Mahoney', with a stylized flourish at the end.

Christopher E. Mahoney
Primary Examiner
Art Unit 2851

Magda Cruz
Patent Examiner
September 5, 2001